

**IN THE DRAWINGS:**

Applicants concurrently file herewith a Submission of Replacement Drawings with eight (8) sheets of replacement drawings to substitute for the original filed drawing sheets. Figs. 4 and 7 are modified to show the features of the detecting unit 110 capable of moving in an up and down direction as recited in the specification. Support for the modified drawings are found on page 13, lines 1-15 of the Applicants' specification as originally filed. No new matter has been added. Applicants respectfully request that the new drawings be accepted.

**REMARKS****Summary of the Office Action**

Claims 1, 2 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,712,841 to *Opheji* in view of U.S. Patent No. 5,757,754 to *Yamamoto et al.* (hereinafter *Yamamoto*) and in further view of U.S. Patent No. 6,584,060 to *Oohchida*.

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Yamamoto* and in further view of *Oohchida*, as applied to claim 1 above, and further in view of U.S. Patent No. 6,637,657 to *Barkan et al.* (hereinafter *Barkan*).

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Yamamoto* and in further view of *Oohchida*, as applied to claim 1 above, and further in view of JP 09-213989 to *Sakakibara et al.* (hereinafter *Sakakibara*).

Claims 6, 7, 16, 17 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Oohchida* .

Claims 8 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Oohchida*, as applied to claims 6 and 16 above, and further in view of *Barkan*.

Claims 9 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Oohchida*, as applied to claims 6 and 16 above, and further in view of *Sakakibara*.

Claims 10, 11 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Oohchida*, and further in view of U.S. Patent No. 6,363,047 to *Yamashita*.

Claims 12 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over

*Opheji* in view of *Oohchida* and further in view *Yamashita*, as applied to claim 10 above, and further in view of U.S. Patent No. 6,404,709 to *Kouno*.

Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Oohchida*, and in further view of *Yamashita*, as applied to claim 10 above, and further in view of *Barkan* .

Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Oohchida*, and in further view of *Yamashita*, as applied to claim 10 above, and further in view of *Sakakibara*.

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Oohchida*, as is applied to claim 21 above, and in further view of U.S. Patent No. 4,926,036 to *Maeda*.

#### **Summary of the Response to the Office Action**

Applicants propose amending claims 1, 6, 10, 16, and 21. Accordingly, claims 1-19 and 21-23 are pending for further consideration.

#### **Drawings**

Applicants concurrently file herewith a Submission of Replacement Drawings with eight (8) sheets of replacement drawings to substitute for the original filed drawing sheets. The new formal drawings amend Figs. 4 and 7 to show the features of the detecting unit 110 capable of moving in an up and down direction as recited in the specification. Support for the modified drawings are found on page 13, lines 1-15 of the Applicants' specification as originally filed. No new matter has been added. Applicants respectfully request that the new drawings be accepted.

**All Claims Comply With 35 U.S.C. §103(a)**

Claims 1, 2 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Yamamoto* and in further view of *Oohchida*.

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Yamamoto* and in further view of *Oohchida*, as applied to claim 1 above, and further in view of *Barkan*.

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Opheji* in view of *Yamamoto* and in further view of *Oohchida*, as applied to claim 1 above, and further in view of *Sakakibara*.

Applicants respectfully submit that newly amended independent claim 1 includes the features of an opening “wherein the opening is defined by the hologram optical element, the bottom of the lead frame package and the side walls of the lead frame package and communicates with an outside of the lead frame package; and a detecting unit . . . wherein the detecting unit is disposed within the opening to move in a horizontal direction and a vertical direction and to rotate in a clockwise and counter-clockwise direction.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Opheji*, *Yamamoto*, or *Oohchida*.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicants are under “no obligation to submit evidence of nonobviousness,” such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of

establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by the Applicants.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because *Opheji*, *Yamamoto*, and *Oohchida*, do not whether alone or in combination, teach or suggest all the recited features of newly amended independent claim 1. Namely, *Opheji*, *Yamamoto*, and *Oohchida* do not teach or suggest at least “wherein the opening is defined by the hologram optical element, the bottom of the lead frame package and the side walls of the lead frame package and communicates with an outside of the lead frame package; and a detecting unit . . . wherein the detecting unit is disposed within the opening to move in a horizontal direction and a vertical direction and to rotate in a clockwise and counter-clockwise direction,” features recited in claim 1.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Opheji*,

*Yamamoto*, and *Oohchida* do not teach or suggest each and every feature of newly amended independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2 and 5 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

With respect to dependent claims 3 and 4, Applicants respectfully submit that the references *Barkan* and *Sakakibara* do not make-up for the above mentioned deficiencies identified in *Opheji*, *Yamamoto*, and *Oohchida*. Accordingly, Applicants respectfully submit that dependent claims 3 and 4 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Similarly, in claims 6, 7, 16, 17 and 21, Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness at least because *Opheji* and *Oohchida*, do not whether alone or in combination, teach or suggest all the recited features of newly amended independent claims 6, 16, and 21. Namely, *Opheji* and *Oohchida* do not teach or suggest at least “wherein the opening is defined by the hologram optical element, the bottom of the lead frame package and the side walls of the lead frame package and communicates with an outside of the lead frame package; and a detecting unit . . . wherein the detecting unit is disposed within the opening to move in a horizontal direction and a vertical direction and to rotate in a clockwise and counter-clockwise direction,” features recited in claims 6, 16, and 21.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re*

*Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Opheji* and *Oohchida* do not teach or suggest each and every feature of newly amended independent claims 6, 16, and 21.

Additionally, Applicants respectfully submit that dependent claims 7 and 17 are also allowable insofar as they recite the patentable combinations of features recited in claims 6 and 16, as well as reciting additional features that further distinguish over the applied prior art.

With respect to dependent claims 8, 9, 18, and 19, Applicants respectfully submit that the references *Barkan* and *Sakakibara* do not make-up for the above mentioned deficiencies identified in *Opheji* and *Oohchida*. Accordingly, Applicants respectfully submit that dependent claims 8, 9, 18, and 19 are also allowable insofar as they recite the patentable combinations of features recited in claims 6 and 16, as well as reciting additional features that further distinguish over the applied prior art.

Similarly to claims 6, 16, and 21 above, Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness for claims 10-15, 22, and 23 at least because *Opheji* and *Oohchida*, do not whether alone or in combination, teach or suggest all the recited features of newly amended independent claims 10 and 21. Namely, *Opheji* and *Oohchida* do not teach or suggest at least “wherein the opening is defined by the hologram optical element, the bottom of the lead frame package and the side walls of the lead frame package and communicates with an outside of the lead frame package; and a detecting unit . . . wherein the detecting unit is disposed within the opening to move in a horizontal direction and a vertical

direction and to rotate in a clockwise and counter-clockwise direction,” features recited in claims 10 and 21.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Opheji* and *Oohchida* do not teach or suggest each and every feature of newly amended independent claims 10 and 21.

With respect to dependent claims 11-15, 22, and 23, Applicants respectfully submit that the references *Yamashita*, *Kouno*, *Barkan*, *Sakakibara*, and *Maeda* do not make-up for the above mentioned deficiencies identified in *Opheji* and *Oohchida*. Accordingly, Applicants respectfully submit that dependent claims 11-15, 22, and 23 are also allowable insofar as they recite the patentable combinations of features recited in claims 10 and 21, as well as reciting additional features that further distinguish over the applied prior art.



**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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